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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/741,042

12/21/2000

Masahiro Juen

XA-8791B

7388

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7590

11/02/2004

MILES & STOCKBRIDGE PC  
1751 PINNACLE DRIVE  
SUITE 500  
MCLEAN, VA 22102-3833

EXAMINER

KUMAR, SRILAKSHMI K

ART UNIT

PAPER NUMBER

2675

DATE MAILED: 11/02/2004

13

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/741,042

Applicant(s)

JUEEN ET AL.

Examiner

Srilakshmi K. Kumar

Art Unit

2675

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2001 and 17 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### ***Drawings***

2. Figures 12 and 13 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claims***

3. Claims 1-6 of this application are considered means-plus-function claims. The following is an explanation of the claims as disclosed by the applicant's specification. Fig. 5 is a block diagram of the electronic camera implementing the principles of the invention according to the applicant.

As to independent claim 1, an image processing apparatus is shown by electronic camera (Fig. 5 and page 14, lines 6-19).

According to the applicant, the operation picture producing means corresponds to the video display processing unit (58), frame memory (64), and overlay processing unit (62).

Art Unit: 2675

The display means corresponds to the display unit (66).

The position input means corresponds to the touch screen (68) and the position detecting unit (32).

The identifying means corresponds to the control unit (30).

The image processing means corresponds to the image pickup unit (54) and recording and reproducing unit (56), and editing unit (60).

The output means corresponds to the output unit (34).

As to dependent claim 2, the display control means corresponds to the control unit (30).

As to dependent claim 3, the image adding means corresponds to the cursor processing unit (36).

As to dependent claim 4, the remote input means corresponds to remote operation receiving unit as shown by applicant in Fig. 8, item 44, and page 20, lines 8-9.

As to dependent claim 5, the image adding means corresponds to the cursor processing unit (36).

As to dependent claim 6, the image processing apparatus is an electronic camera (Fig. 5, page 13, line 1.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2675

5. Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art.

As to independent claim 1, Applicant discloses in the Related Background Art of the specification, specifically, pages 1, line 20-page 5, line 2, an image processing apparatus, which is shown by the Applicant as a multi functional electronic camera in Fig. 13 and page 1, lines 20-23 and page 2, lines 1-4.

In the limitations of claim 1, Admitted prior art claims an operation picture producing means, this is shown by the applicant in the applicant's specification on page 2, lines 7-page 3, line 26 and is explained as follows. The multi-functional electronic camera shown in Fig. 13, is the image producing apparatus. Fig. 12 of the application is shown as background prior art as will be explained as follows: The operational picture producing means is the combination of the video display processing unit (58), frame memory (64) and overlay processing unit (62). The video display processing unit, processes the image by converting its pixel density, so as to produce an image to be projected on the finer portion in the camera window, and transmits the image to the overlay processing unit. Also included in the operation picture producing means is a frame memory (64), which stores the image displayed and also transmits the image to the overlay processing unit. The overlay processing unit (62) superimposes or overlays the image of the finder from the video display processing unit on the image displayed as windows, which is received from the frame memory. This is done to produce the operation picture. The above discloses the components and the function of the operation picture producing means.

Admitted prior art discloses display means for displaying said operation picture as shown by the display unit 66 and disclosed by page 4, lines 1-2 of the applicant's specification.

Art Unit: 2675

Admitted prior art discloses on page 4, line 3-6 a position input means in the form of a touch display. A position on the display unit is entered through the touch screen (68), which is operated by the operator who touches the screen by pushing down on the screen with a pen-line device or directly pushes down the screen. This corresponds to the claim limitation of position input means including a portion placed over a screen of said display means to detect a touch operation as said external operation, said position input means having a first operating mode to enter a position designated by the touch operation as an absolute position or exact position on the operation picture displayed on said display means. Although the position detecting unit is not shown, it is obvious to one of ordinary skill in the art that touch panels include a position detecting units to detect the origin or the exact location of the touch or selection by pen input of the touch panel.

On page 4, lines 7-19, Admitted prior art discloses identifying means in the form of a control unit (50), which identifies an icon displayed at the position entered through the touch screen, and instructs respective units of the camera to carry out the processing represented by the specified icon. This corresponds to the claim limitation of identifying means for identifying a selected image processing function, among said plurality of image processing functions, based on the position entered through said position input means; image processing means for carrying out the image processing function identified by said identifying means;

Admitted prior art discloses image processing means in the form of an image pickup unit which transmits a still or movie image to the recording and reproducing unit (56) which compresses the image and writes the compressed image into a recording medium such as a magnetic disk and an editing unit (60).

Art Unit: 2675

Admitted prior art discloses output means in the form of outputting the operation picture to an external display device, such as a television on page 4, lines 20-page 5, lines 12. This corresponds to the claim limitation of output means for outputting the operation picture produced by said operation picture producing means to an external display device, wherein, when the operation picture is output to the external display device through said output means. Although Admitted prior art does not disclose an output unit, however, this is obvious to one of ordinary skill in the art because in order to output to an external display, an output means is necessary.

As per MPEP 2184, 35 USC 112, sixth paragraph, claim 1 is considered a means-plus-function claim. The following claim language, “where said position input means can operate in a second operating mode to enter the position designated by the touch operation as a relative position on the operation picture displayed on the external display device”, is considered to be functional language, thus, does not patentably distinguish the limitations of claim 1.

As to independent claim 6, limitations of claim 1, and further comprising, wherein the image processing apparatus is an electronic camera. Admitted prior art discloses in an image processing apparatus, which is shown by the Admitted prior art as a multi functional electronic camera in Fig. 13 and page 1, lines 20-23 and page 2, lines 1-4.

6. Claims 3, 7, 9, 10, 12-14, 16, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art in view of Lichtenstein (US 5,428,417).

As to independent claims 7 and 13, limitations of claim 1, and further comprising, a position input portion which inputs a position designated by the operator on the operation picture displayed on the external display device.

Lichtenstein discloses a visual lecture aid device comprising an image processing device (Fig. 1, item 24). Although Lichtenstein discloses this to be a slide projector, in col. 22, lines 42-49, Lichtenstein discloses where the invention is not limited to the slide projector shown, but can include a camera. Lichtenstein discloses an external display (Fig. 1, item 19). Lichtenstein discloses in col. 7, lines 16-22, where the external display device incorporates a remote touch panel assembly by which the position designated by the touch operation as a relative position on the operation picture display on the external display device is entered.

It would have been obvious to one of ordinary skill in the art to incorporate the touch features of the external display device of the Lichtenstein system with the admitted prior art because, the features of the Lichtenstein system and that of admitted prior art differ based on the touch feature of the external display device of Lichtenstein, and where the touch feature is advantageous as it permits the user flexibility in manipulating the image either on the main display or the external display.

As to dependent claim 3, limitations of claim 1, and further comprising, image adding means, Applicant discloses the image adding means on page 12, lines 14-18, where the image adding means adds a cursor to the display, and indicating the position entered through said position input means, to the operation picture produced by said operation picture producing means and supplied to said output means. Lichtenstein discloses means for adding a cursor (col. 7, lines 16-28, the icon pointers). It would have been obvious to one of ordinary skill in the art to incorporate the feature of adding a cursor indicating the position entered through said position input means as the feature of a cursor is advantageous as it permits the user to add text or visually point out areas of the image.



As to dependent claim 9, limitations of claim 7, and further comprising, wherein said position input portion includes a touch responsive unit having a portion placed over a screen of said image display unit with which the operator can designate a position on the operating picture displayed on the external display device by touch operation. Lichtenstein discloses a visual lecture aid device comprising an image processing device (Fig. 1, item 24). Although Lichtenstein discloses this to be a slide projector, in col. 22, lines 42-49, Lichtenstein discloses where the invention is not limited to the slide projector shown, but can include a camera. Lichtenstein discloses an external display (Fig. 1, item 19). Lichtenstein discloses in col. 7, lines 16-22, where the external display device incorporates a remote touch panel assembly by which the position designated by the touch operation as a relative position on the operation picture display on the external display device is entered.

It would have been obvious to one of ordinary skill in the art to incorporate the touch features of the external display device of the Lichtenstein system. The features of the Lichtenstein system and that of admitted prior art differ based on the touch feature of the external display device of Lichtenstein, and where the touch feature is advantageous as it permits the user flexibility in manipulating the image either on the main display or the external display.

As to dependent claim 10, limitations of claim 9, and further comprising, a second operating mode to input a position designated by the operator via said touch responsive unit on the operation picture displayed on the external display device. Lichtenstein discloses a visual lecture aid device comprising an image processing device (Fig. 1, item 24). Although Lichtenstein discloses this to be a slide projector, in col. 22, lines 42-49, Lichtenstein discloses where the invention is not limited to the slide projector shown, but can include a camera.

Art Unit: 2675

Lichtenstein discloses an external display (Fig. 1, item 19). Lichtenstein discloses in col. 7, lines 16-22, where the external display device incorporates a remote touch panel assembly by which the position designated by the touch operation as a relative position on the operation picture display on the external display device is entered.

It would have been obvious to one of ordinary skill in the art to incorporate the touch features of the external display device of the Lichtenstein system. The features of the Lichtenstein system and that of admitted prior art differ based on the touch feature of the external display device of Lichtenstein, and where the touch feature is advantageous as it permits the user flexibility in manipulating the image either on the main display or the external display.

As to dependent claim 14, limitations of claim 13, and further comprising, wherein said position is designated by the operator performing a touch operation of a touch responsive unit having a touch portion placed over a screen of said image display unit (see admitted prior art, specification page 1, line 20-page 5, line 2).

As to dependent claim 16, limitations of claim 13, and further comprising, wherein said inputting constitutes one of two selectable inputting modes, the other of said inputting modes includes inputting a position designated by the operator on the operation picture displayed on said image display unit (col. 6, lines 47-68, col. 13, lines 6-28, col. 20, lines 7-20).

As to dependent claims 12 and 17, limitations of claims 7, and 13, and further comprising, wherein said image processing apparatus is an electronic camera. Applicant discloses in an image processing apparatus, which is shown by the Applicant as a multi functional electronic camera in Fig. 13 and page 1, lines 20-23 and page 2, lines 1-4.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art and Lichtenstein as applied to claim 1 above, and further in view of Kamamoto et al (US 5,982,429).

As to dependent claim 2, limitations of claim 1, and further comprising, display control means, Admitted prior art discloses the display control means as the control unit in the specification on page 2, lines 7 and in Fig. 12, item 50. Applicant discloses the functionality of the display control means in the specification, page 10, lines 12-15 and Fig. 2, item 22 for turning off a display of the operation picture on said display means when the operation picture is output to the external display device through said output means. Lichtenstein discloses a display control means in Fig. 1, item 17 and col. 7, lines 1-7.

Admitted prior art and Lichtenstein do not disclose turning off a display. Kamamoto et al disclose a video camera with display means as the viewfinder and a larger external display as the liquid crystal display (shown in Fig. 2, item 6, the viewfinder; item 7, the larger liquid crystal display, col. 14, lines 49-59). In col. 14, lines 61-65, Kamamoto et al disclose switching an image signal between the viewfinder and the larger liquid crystal display, whereby the viewfinder will turn off when the image is being displayed on the larger external liquid crystal display. It would have been obvious to one of ordinary skill in the art to incorporate the feature of turning off the display of the display means when the operation picture is output to the external display as in col. 2, lines 58-61, Kamamoto et al disclose whereby switching the image signal between both displays instead of displaying on both displays at once, power consumption is reduced.

Art Unit: 2675

8. Claims 4, 5, 8, 11, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art in view of Lichtenstein as applied to claims 1, 7 and 13 above, and further in view of Autry et al (US 5,724,106).

As to dependent claim 4, limitations of claim 1, and further comprising, remote input means, Applicant discloses a remote input means in the form of a remote control in the Specification, page 11, lines 15-page 12, line 4 and Fig. 3, item 24) for allowing the external operation to be performed by a remote operation, and wherein, when the operation picture is output to the external display device through said output means, said position input means operates in said second mode to enter the position designated by the remote operation as a relative position on the operation picture displayed on the external display device, said identifying means identifies a selected image processing function among said plurality of image processing functions, based on the position entered through said remote input means.

Admitted prior art and Lichtenstein do not disclose a remote input means for allowing the external operation to be performed by a remote operation on the operation picture displayed on the external display device. Autry et al disclose a hand held remote control device for controlling external operations performed as part of a graphical user interface (col. 3, lines 40-48). Although the system of Autry et al is used with a personal computer and a display device, in col. 4, lines 9-11, the remote can be used to control images from a digital camera. Autry et al in col. 13, lines 37-48, disclose when the signals are received from the remote, the command is identified and applied accordingly. It would have been obvious to one of ordinary skill in the art to incorporate the remote controller of Autry et al in to that of Lichtenstein as in col. 3, lines 41-

Art Unit: 2675

48, Autry et al disclose the use of the remote with a home entertainment system including a external display device.

As to dependent claim 5, limitations of claim 4, and further comprising, image adding means, Applicant discloses the image adding means on page 12, lines 14-18, where the image adding means adds a cursor to the display, and indicating the position entered through said position input means, to the operation picture produced by said operation picture producing means and supplied to said output means. Lichtenstein discloses means for adding a cursor (col. 7, lines 16-28, the icon pointers). It would have been obvious to one of ordinary skill in the art to incorporate the feature of adding a cursor indicating the position entered through said position input means as the feature of a cursor is advantageous as it permits the user to add text or visually point out areas of the image.

As to dependent claim 8, limitations of claim 7, and further comprising, wherein said position input portion is constructed to input a position designated by the operator on the operation picture displayed on the external display device with a remote control which provides a signal to said position input portion. Autry et al disclose a hand held remote control device for controlling external operations performed as part of a graphical user interface (col. 3, lines 40-48). Although the system of Autry et al is used with a personal computer and a display device, in col. 4, lines 9-11, the remote can be used to control images from a digital camera. Autry et al in col. 13, lines 37-48, disclose when the signals are received from the remote, the command is identified and applied accordingly. It would have been obvious to one of ordinary skill in the art to incorporate the remote controller of Autry et al in to that of Lichtenstein as in col. 3, lines 41-

Art Unit: 2675

48, Autry et al disclose the use of the remote with a home entertainment system including a external display device.

As to dependent claim 11, limitations of claim 10, and further comprising, wherein said position input portion is constructed to input a position designated by the operator on the operation picture displayed on the external display device with a remote control which provides a signal to the position input portion. Autry et al disclose a hand held remote control device for controlling external operations performed as part of a graphical user interface (col. 3, lines 40-48). Although the system of Autry et al is used with a personal computer and a display device, in col. 4, lines 9-11, the remote can be used to control images from a digital camera. Autry et al in col. 13, lines 37-48, disclose when the signals are received from the remote, the command is identified and applied accordingly. It would have been obvious to one of ordinary skill in the art to incorporate the remote controller of Autry et al in to that of Lichtenstein as in col. 3, lines 41-48, Autry et al disclose the use of the remote with a home entertainment system including a external display device.

As to dependent claim 15, limitations of claim 13, and further comprising, wherein said position is designated by the operator with a remote control unit which provides a signal to the image processing apparatus. Autry et al disclose a hand held remote control device for controlling external operations performed as part of a graphical user interface (col. 3, lines 40-48). Although the system of Autry et al is used with a personal computer and a display device, in col. 4, lines 9-11, the remote can be used to control images from a digital camera. Autry et al in col. 13, lines 37-48, disclose when the signals are received from the remote, the command is identified and applied accordingly. It would have been obvious to one of ordinary skill in the art

to incorporate the remote controller of Autry et al in to that of Lichtenstein as in col. 3, lines 41-48, Autry et al disclose the use of the remote with a home entertainment system including a external display device.

***Response to Arguments***

9. Applicant's arguments, see Pre-Amendment A, filed March 30, 2001, with respect to the rejection(s) of claim(s) 1-17 under 35 USC 102 (e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Admitted Prior Art, Lichtenstein (US 5,428,417), Kamamoto et al (US 5,982,429), and Autry et al (US 5,724,106).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Srilakshmi K. Kumar whose telephone number is 703 306 5575. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, xxxx xxxx can be reached on xxx xxx xxxx. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Srilakshmi K. Kumar

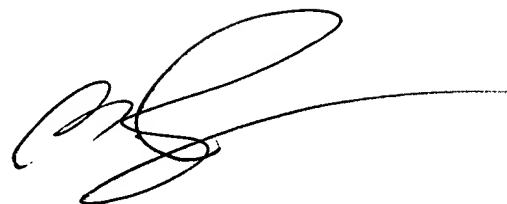
Application/Control Number: 09/741,042

Page 15

Art Unit: 2675

Examiner  
Art Unit 2675

SKK  
October 21, 2004

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**MICHAEL RAZAVI**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2600**